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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR		ATTORNEY DOCKET NO.
09/484,629	01/18/00	ROBINSON	I	3265/85705

HM12/0202

Banner & Witcoff LTD
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Boston MA 02109

EXAMINER	
WOITACH,J	
ART UNIT	**PAPER NUMBER**
1632	11

DATE MAILED: 02/02/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

File

Office Action Summary	Application No. 09/484,629	Applicant(s) Robinson et al.
	Examiner Joseph Woitach	Group Art Unit 1632

☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-29 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-29 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

The Sequence Listing filed November 8, 2000 , paper number 9, has been received and entered. However, examination of the specification, claims and sequence listing indicates several inconsistencies with the sequences submitted. For example, page 5 of the specification recites the polypeptide set forth in SEQ ID NOs: 2, 4, or 6 which is consistent with claim 1, however SEQ ID NOs: 2, 4 and 6 are polynucleotide sequences. Further, the sequence listing submitted does not contain a single polypeptide sequence SEQ ID NO. Finally, the polypeptide sequences listed in the claims, for example claims 6 and 7, do not have SEQ ID NOs associated with them. Therefore, the application is not in sequence compliance.

The nucleotide sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 C.F.R. 1.821 - 1.825. Applicant's attention is directed to the final rulemaking notice published at 55 FR 18230 (May 1, 1990), and 1114 OG 29 (May 15, 1990). If the effective filing date is on or after July 1, 1998, see the final rulemaking notice published at 63 FR 29620 (June 1, 1998) and 1211 OG 82 (June 23, 1998).

For a complete response to this office action, applicant must submit the required material for sequence compliance. Correction of the specification and claims is also suggested.

In addition many of the claims are multiple dependent claims because 'in any one of claims 1-7' is repeatedly recited in addition to other claims. For the sake of compact prosecution,

recitation of 'any one of claims 1-7' has been interpreted within the context of the claimed invention for the Restriction Requirement. Claims 1-29 are pending and currently under examination.

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-7 and 27, drawn to a 5'OT-EST polypeptide, classified in class 530, subclass 402.

II. Claims 8-16 and 28, drawn to nucleic acid encoding a 5'OT-EST polypeptide, a vector containing said nucleic acid and an isolated cell containing said gene, classified in class 536, subclass 23.1; class 435, subclass 325.

III. Claim 17-22, 29 and 24-26, drawn to a transgenic non-human animal expressing a 5'OT-EST polypeptide and a method of using said animal, classified in class 800, subclass 13 and class 800, subclass 3.

IV. Claim 23 and 24-26, drawn to a non-transgenic non-human animal possessing an obese phenotype and a method of using said animal, classified in class 800, subclass 8 and class 800, subclass 9.

Claims 24-26 are methods generic to both Groups III and IV, and will be examined to the extent that they encompass the elected invention.

The inventions are distinct, each from the other because of the following reasons:

Groups I-III are drawn to products and methods which are capable of separate use. The polypeptide of Group I can be used for creating antibodies, the polynucleotide of Group II can be used for expression for cells in culture and the transgenic non-human animal of Group III can be used to determine the effect of 5'OT-EST on the physiology of a tissue *in vivo*.

Groups I-III and IV are drawn to products and methods which are different and distinct. The non-transgenic non-human possessing obese phenotypes of Group IV may be phenotypically and materially different from the transgenic non-human animal of Group III, moreover, the materials and method steps to create a transgenic non-human animal are materially different and unique from obtaining a non-transgenic non-human animal with desired phenotypes. The product of Groups I and II are unrelated to Group IV because the neither needed nor used in the non-transgenic non-human animal and methods of Group IV.

The inventions above are independent and distinct, each from the other. They have acquired a separate status in the art as a separate subject for inventive effect and require independent searches. The search for each of the above invention is not co-extensive particularly with regard to the literature search. Further, a reference which would anticipate the invention of any one Group would not necessarily anticipate or make obvious any of the other groups.

For these reasons restriction for examination is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer and inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Woitach, whose telephone number is (703) 305-3732. The examiner can normally be reached on Monday through Friday from 7:00 to 4:30 (Eastern time).

If attempts to reach the examine by telephone are unsuccessful, the examiner's supervisor, Karen M. Hauda, can be reached on (703) 305-6608. The fax number for group 1600 is 1 (800)308-4242.

An inquiry of a general nature or relating to the status of the application should be directed to Kay Pickney whose telephone number is (703) 305-3553.

Joseph T. Woitach

JILL D. MARTIN
PATENT EXAMINER
AU 1632

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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/484,629	01/18/2000	Robinson et al.	18396/1140

EXAMINER	
Joseph T. Woitach	
ART UNIT	PAPER NUMBER
1632	11

Please find below a communication from the EXAMINER in charge of this application

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). This application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason(s) set forth on the attached Notice to Comply With Requirements for Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures.

See attached action for further detailed comments.

Any inquiry concerning this communication should be directed to Examiner Joseph T. Woitach Art Unit 1632, whose telephone number is (703)305-3732.

Any inquiry of a general nature or relating to the status of this application sould be directed to the Technology Center receptionist whose telephone number is (703)308-0196.

APPLICANT IS GIVEN A ONE MONTH EXTENDABLE PERIOD WITHIN WHICH TO COMPLY WITH THE SEQUENCE RULES, 37 CFR 1.821-1.825. Failure to comply with these requirements will result in ABANDONMENT of the application under 37 CFR 1.821(g). Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136. In no case may an applicant extend the period for response beyond the six month statutory period. Applicant is requested to return a copy of the attached Notice to Comply with the response.

Application No. 08/484,629

NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES

Applicant must file the items indicated below within the time period set the Office action to which the Notice is attached to avoid abandonment under 35 U.S.C. § 133 (extensions of time may be obtained under the provisions of 37 CFR 1.136(a)).

The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 C.F.R. 1.821 - 1.825 for the following reason(s):

☐ 1. This application clearly fails to comply with the requirements of 37 C.F.R. 1.821-1.825. Applicant's attention is directed to the final rulemaking notice published at 55 FR 18230 (May 1, 1990), and 1114 OG 29 (May 15, 1990). If the effective filing date is on or after July 1, 1998, see the final rulemaking notice published at 63 FR 29620 (June 1, 1998) and 1211 OG 82 (June 23, 1998).

☐ 2. This application does not contain, as a separate part of the disclosure on paper copy, a "Sequence Listing" as required by 37 C.F.R. 1.821(c).

☐ 3. A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 C.F.R. 1.821(e).

☒ 4. A copy of the "Sequence Listing" in computer readable form has been submitted. However, the content of the computer readable form does not comply with the requirements of 37 C.F.R. 1.822 and/or 1.823, as indicated on the attached copy of the marked -up "Raw Sequence Listing."

☐ 5. The computer readable form that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A Substitute computer readable form must be submitted as required by 37 C.F.R. 1.825(d).

☐ 6. The paper copy of the "Sequence Listing" is not the same as the computer readable from of the "Sequence Listing" as required by 37 C.F.R. 1.821(e).

☐ 7. Other: _____

Applicant Must Provide:

☒ An initial or substitute computer readable form (CRF) copy of the "Sequence Listing".

☒ An initial or substitute paper copy of the "Sequence Listing", as well as an amendment directing its entry into the specification.

☒ A statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 C.F.R. 1.821(e) or 1.821(f) or 1.821(g) or 1.825(b) or 1.825(d).

For questions regarding compliance to these requirements, please contact:

For Rules Interpretation, call (703) 308-4216
For CRF Submission Help, call (703) 308-4212
PatentIn Software Program Support
Technical Assistance.....703-287-0200
To Purchase PatentIn Software.....703-306-2600

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